

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Katsunobu HAYASHI

Confirmation No.: 7831

Appl. No.: 09/683,829

Tech. Center: 3694

Filed : February 20, 2002

Examiner: Mary Da Zhi Wang CHEUNG

For : COMPENSATION CONTRACT SUPPORTING SYSTEM, METHOD FOR
SUPPORTING COMPENSATION CONTRACT, AND PROGRAM THEREOF

DECLARATION BY CAROLINA RIOS IN SUPPORT OF RENEWED PETITION
UNDER 37 C.F.R. 1.181
FOR WITHDRAWAL OF HOLDING OF ABANDONMENT

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby declare that:

1. I joined the firm HersHKovitz & Associates, LLC, on June 1, 2008. I normally work on patent matters including docketing. As such, I am responsible for the PROLAW docketing system and the Yahoo backup docketing system at HersHKovitz & Associates, LLC.

2. When an e-mail notification of an Office Action is received by the Firm, I print out a copy of the Office Action, and annotate a docketing worksheet I use to reflect the need for docketing the Office action later on in the day.

3. Docketing in PROLAW consists of an entry of the date of the Office Action and the number of months set for response. The PROLAW docketing software automatically computes the initial response due date and each subsequent monthly due date until the maximum 6 month inextendible deadline.

4. In addition to the PROLAW docket system, the Firm uses the Yahoo calendar system as a back-up to the PROLAW docket system.

5. My daily docketing routine is to print out a copy of that day's activities as they appear in the PROLAW docket system and the back-up Yahoo calendar system. I then pull all the cases that have docket entries for that day, and go over the docket entries with Dinh Nguyen, one of the patent attorneys at the Firm. In order to ensure that no date is missed, once I complete the docket review with Mr. Nguyen, I repeat the process with Abe HersHKovitz, the head of the Firm. In addition to docketing new Office Actions in the PROLAW docket system, I manually annotate the Yahoo docket print-out with the appropriate dates for forwarding the Office Action to the client (3 days after receipt), the due date for an analysis of the Office Action (one month after receipt), and an inquiry as to whether we received instructions from the client (two months after receipt of the Office Action). I then update the Yahoo calendar system based on my manual notes.

6. To the best of my knowledge and recollection, I process all e-mails received from the USPTO in the manner described above. On rare occasions, due to e-mail problems such as an e-mail being sent directly to the Firm's junk e-mail box or other folders, when we are

unaware of a PTO's e-mail relative to an Office Action, the USPTO sends us a post card reminder that the Private PAIR records were not reviewed for that Office Action during the period in question. I have no recollection of having received a USPTO postcard reminder of this type for this case. Had I received one, I would of course have accessed private PAIR at that point and would have followed the steps described above.

7. After the docketing process described above, I prepare a reporting letter of the Office Action to the client, or give the file to another legal assistant to prepare the report for review by one of the patent attorneys or agents in the Firm before sending it to the client. My review of the file of the above-captioned application reveals that there were no records of the Office action in the file.

8. Once an Office action is reported to a client, the physical file is placed on a special shelf called "awaiting client instructions" shelf. This shelf is reviewed by a legal assistant on a monthly basis to ensure that appropriate reminders are sent to the client if instructions have not been received. This is our firm's backup system in addition to PROLAW and Yahoo docketing.

9. On or about October 8, 2008, upon receipt from the USPTO of the e-mail notification of the Office Action regarding the Notice of Abandonment, I immediately accessed PAIR, printed the document and matched it with the file. After docketing the received Office Action, I prepared the reporting letter for the client. I retrieved the file from the regular filing shelf, as I did not find it where I expected to find it, i. e., the "awaiting

client instructions” shelf. I then showed the file along with the printout and reporting letter to Mr. Nguyen. As the Office Action was a Notice of Abandonment, we reviewed the file and were surprised to see that the file did not have an Office Action after Applicant’s filed Response of December 6, 2007.

10. At that point, I called the USPTO to inquire about the situation. A USPTO official stated that records indicated that for this Office Action, there was an e-mail notification on March 18, 2008 and an electronic review of the document on March 19, 2008.

11. While I am not in a position to state what happened in the March 18th time frame, I can state that this Office Action was not docketed in PROLAW, and that a search of our records, including the paper file and the Firm’s electronic file fails to reveal review or receipt of the Office Action in March 2008. Thus, even though I was not with the Firm in March 2008, the docketed entry would have appeared in PROLAW while I was handling PROLAW docketing on July 18, 2008, August 18, 2008, and sometime prior to September 18, 2008, as a reminder of the need to file a Response.

12. I reviewed the Firm’s electronic records and paper file and did not see the presence of the Office Action of March 18, 2008, or any PTO post card reminders showing that the Private PAIR records were not reviewed for that Office action. Furthermore, my review of the Firm’s docket system showed no entries for responding to the Office action of March 18, 2008, or for reporting that action to the client.

13. After discussing the Notice of Abandonment with Mr. HersHKovitz, he instructed

me to docket on Yahoo for filing a Petition to Withdraw the Holding of Abandonment.

14. I then proceeded to docket on Yahoo and to enter in PROLAW the belatedly obtained Office action of March 18, 2008.

15. Exhibit A is a copy of the records that I printed out, which is a PROLAW system docket specifically for the application at issue (attorney's docket number P13205). If the Office Action at issue had been received, the docket manager would have made entries in Exhibit A to show that for attorney's docket number P13205, an Office Action dated March 18, 2008 was received and entered the due dates related thereto, with or without the extensions of time. The second entry on this docket, which shows an Office Action date of March 18, 2008, was entered by me on November 13, 2008 upon receiving the Notice of Abandonment and obtaining a copy of the Office Action.

16. The items in the "Event type" column were automatically updated by the PROLAW system by populating those fields with event types such as "Response to Final Office Action due," "Response to Office Action filed," "Notice of Appeal or Request for Continued Examination," etc. Again, these events were automatically generated in the docket print-out of Exhibit A after I updated the docket upon receiving the Notice of Abandonment and entering the information regarding the Office Action on November 13. Since these entries were populated after the fact, there is no date entered in the "Completed Date" column for these events.

17. Exhibit B is a print-out of the records that I printed, which is a PROLAW docket

calendar for the months of March (starting on March 17, 2008), April, May, June, July, August and September (up to September 28, 2008). If the Office Action at issue had been received, the docket manager would have made entries to show in Exhibit B for attorney's docket number P13205 and certain due dates for P13205 would appear consisting of entries such as "Detailed Analysis of the Office Action," "Response to Office Action due," "Reminder sent to Client regarding Office Action," "Instructions received from Client?," "Detailed Analysis sent to client?," etc. As can be seen from Exhibit B, no such indications or entries were made by my predecessor for P13205.

18. Exhibit C is a print-out of the Yahoo calendar for the week of March 18, 2008. I confirm that this is the type of Yahoo calendar print-out that is in use since I joined the Firm in June 2008. To the best of my knowledge, the absence of any entries is consistent with an indication that the Office Action of March 18, 2008 was not received, or if it was received, the Action had been reported to the client (which would have resulted in deletion of that entry).

19. Exhibit D is a print-out of the Yahoo calendar with a query for any entry related to Docket No. P13205. I confirm that this is the type of Yahoo calendar print-out that would indicate all docketed entries for Docket No. P13205. The absence of an entry related to the Office Action in question indicates that the Office Action was never docketed in the Yahoo calendar or that a response had already been filed (which would have resulted in deletion of that entry).

20. I have reviewed the copies of the records used by HersHKovitz & Associates, LLC, where the Office Action of March 18, 2008 would have been entered had it been received, including Exhibits A-F attached to the Renewed Petition and hereby state that they are accurate.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

December 30, 2008


Carolina Rios